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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,737	04/09/2004	Jochen Schweinbenz	10191/3610	1521
26646 7590 12/22/2006 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004			EXAMINER PAPE, ZACHARY	
			ART UNIT	PAPER NUMBER
			2835	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/22/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/821,737

Applicant(s)

SCHWEINBENZ ET AL.

Examiner

Zachary M. Pape

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 5-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 5-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 February 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/6/2006 has been entered.

### *Drawings*

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. **Therefore, the circuit board, and the cover of claim 1 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.**

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

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consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. The disclosure is objected to because of the following informalities:

On page 2 lines 31-32, the specification recites, "a cover that is not illustrated as well as a p.c. board that is also not illustrated". Should the drawings be amended to show the p.c. board and the cover, the specification should also be amended to reflect the changes.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1, 5, 7-12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Clamp et al. (US 6,302,190).

With respect to claim 1, Clamp et al. teaches a housing for electronic control units, wherein the housing is situated in a motor vehicle, the housing comprising: a bottom section (30), a circuit board affixed on the bottom section (Wherein the ECU 20 inherently has a circuit board and ECU 20 is affixed on the bottom section (30); a cover (20) affixed on the bottom section (See Column 2, Lines 40-44, Column 3, Lines 11-14); and a cooling device (Generally 30, which includes 40, 46, and 48) for enabling heat to be dissipated from the housing via a liquid flowing there-through (Column 2, Lines 31-39), wherein the cooling device is integrally formed in the bottom section (As illustrated in Fig 2), and wherein the bottom section is formed as a cooling plate that includes an integrated, one-piece cooling channel (40).

With respect to claim 5, Clamp et al. further teaches sectional members (52) for conducting heat and reinforcing the bottom section (30) are situated on an outside of the cooling channel (As illustrated in Fig 6).

With respect to claim 7, Clamp et al. further teaches that the cooling channel has a round cross-section (As illustrated in Figs 2 and 7, 46 and 48 both have round cross sections).

With respect to claim 8, Clamp et al. further implies in Fig 9 that an inlet of the cooling channel (94) and an outlet of the cooling channel (102) have threaded connectors leading into and out of the bottom section.

With respect to claim 9, Clamp et al. further teaches that the cooling plate has separate cooling channels (As illustrated in Fig 2, the first cooling channel is located near 40 and a second, separate cooling channel is located near 44).

With respect to claim 10, Clamp et al. further illustrates that the separate cooling channels are connected by at least one separate cross hole (Running along the left side of the bottom as illustrated in Fig 2 and present office action Fig 1 below).

With respect to claims 11 and 12 the limitations of the claim have been given little patentable weight because the claims contain only limitations pertaining to the process of making the product. In the present case, the process by which the product is made does not structurally change the final product made. Since the product in the product-by-process claim is the same as or obvious from a product of the prior art (of Clamp et al.), the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985).

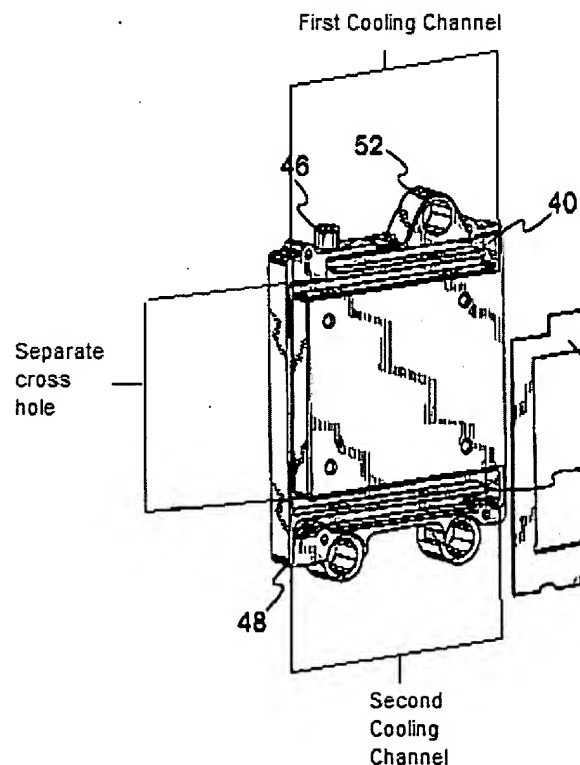


Fig 1

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clamp et al. in view of Watari et al. (US 4,652,970).

With respect to claim 6, Clamp et al. teaches the limitations of claim 1 above but is silent as to a linearly designed cooling channel. Watari et al. teaches the conventionality of having a cooling channel (43) which is linear and passes through the bottom section in a linear manner (As illustrated in Fig 7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Watari et al. with that of Clamp et al. to provide effectively cooling to devices (Column 4, Lines 25-26).

***Response to Arguments***

6. Applicant's arguments filed 11/6/2006 have been fully considered but they are not persuasive.

With respect to the Applicants' remarks that, "no suggestion is made that this ECU has a circuit board", the Examiner respectfully notes that an Electronic Control Unit inherently has a circuit board. Should the Applicant's disagree, the Examiner

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respectfully requests that the Applicant's provide evidence to the contrary (I.E. an electronic control unit which does not have a circuit board).

With respect to the Applicants' remarks that, "Clamp clearly does not disclose or suggest that the cooling plate has "an integrated, one-piece cooling channel", the Examiner respectfully disagrees. As disclosed in Fig 2 of Clamp, the bottom section (30) which includes the cooling device is shown as being constructed as one-piece as claimed where the channel (40) is integrated therewith. Further in Column 2, Lines 35-37, Clamp discloses that the walls 42, 44 are "cast" into the upper and lower sides which suggests that the device is created as a whole with particular attention being paid to create the walls.

Applicant's arguments with respect to claim 6 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary M. Pape whose telephone number is 571-272-2201. The examiner can normally be reached on Mon. - Fri. (7:00am - 5:00pm).

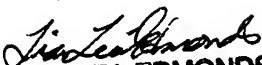
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Darren Schuberg can be reached at 571-272-2044. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ZMP

  
**LISA LEA-EDMONDS**  
**PRIMARY EXAMINER**